

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

GOODMAN

Opposition No. 111,400 ✓

McCormick & Schmick  
Management Group

v.

Reese S. Cooper, d/b/a  
Jakes' Bar & Grill

Concurrent Use No. 1,113 ✓

McCormick & Schmick  
Management Group

v.

Reese S. Cooper, d/b/a  
Jake's Bar & Grill

Before Hanak, Wendel, and Holtzman, Administrative Trademark  
Judges

By the Board:

In an order dated June 21, 1999, the Board allowed applicant time to submit a proper amendment to amend application Serial No. 75/290,996 to a concurrent use application, as contemplated by the parties' settlement agreement, and deferred action on opposer's withdrawal of the opposition proceeding, which was contingent upon the

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Board's acceptance of applicant's amendment. The Board also requested that the parties clarify whether opposer's pleaded registrations in the notice of opposition, Registration Nos. 1,306,235, 1,328,806, and 1,610,827, would be subject to the concurrent use proceeding and advised opposer that its concurrent use application, application Serial No. 75/625,487, should be amended to comply with Trademark Rule 2.42.

On July 19, 1999, in response to the Board order, applicant filed a second motion to amend application Serial No. 75/290,996 to a concurrent use application. Applicant also informed the Board that the parties' settlement agreement does not contemplate concurrent use restrictions on opposer's pleaded registrations because the goods and services are different and not likely to cause confusion. Also on July 19, 1999, opposer filed its response to the Board order, confirming that the parties have agreed that opposer's pleaded registrations will not be subject to the concurrent use proceeding and indicating that it was amending its concurrent use application, application Serial No. 75/625,487, to comply with the requirements of Trademark Rule 2.42.

Inasmuch as applicant's amendment to application Serial No. 75/290,996 complies with Trademark Rule 2.42, the amendment is granted, and the application is amended to an

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application for a concurrent use registration. Opposer's proposed amendment to conform concurrent use application Serial No. 75/625,487 with Trademark Rule 2.42 is also acceptable, and is hereby granted.

In view thereof, opposer's motion to withdraw the opposition is granted, and the Opposition No. 111,400 is dismissed without prejudice. A concurrent use proceeding, namely, Concurrent Use No. 1,113 is hereby instituted under the provisions of Section 2(d) of the Trademark Act of 1946. The concurrent use proceeding involves the following parties.

Applicant	McCormick & Schmick Holding Corp.
Serial No.	75/625,487
Service Mark	JAKE'S
Services	restaurant and bar services
Filing Date	January 22, 1999
Territory of Use	for the area comprising the entire United States except the states of Delaware, New Jersey and Pennsylvania
Attorney	Joan L. Dillon, Esq. Kilpatrick Stockton LLP 1100 Peachtree Street - Suite 2800 Atlanta, Georgia 30309-4530
Applicant	Bruce S. Cooper d/b/a Jake's Bar and Grill

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Serial No.	75/290,996
Service Mark	JAKE'S
Services	restaurant and bar services
Filing Date	May 13, 1997
Territory of Use	for the area comprising the states of Delaware, New Jersey and Pennsylvania
Attorney	Manny Pokotilow Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd. 12 <sup>th</sup> Floor, Seven Penn Center 1635 Market Street Philadelphia, Pennsylvania 19103-2212

In view of the settlement agreement entered into between the parties with respect to the concurrent use of their marks, the Board finds it unnecessary to allow the parties time to file statements under Rule 2.99, if desired.<sup>1</sup> Instead, the agreement will be reviewed by the Board as a potential means for resolving this proceeding.

By their settlement agreement, the parties each shall have exclusive right to use their mark for the services set forth in their application in the geographic area assigned, and the parties agree that the concurrent use obligations are perpetual, unless the marks are abandoned by either party.

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<sup>1</sup> The agreement has been identified in the body of the settlement agreement as a "concurrent use agreement."

While a settlement agreement may well serve as the basis for the resolution of a concurrent use proceeding, the burden of proof remains upon the parties to establish that there is no likelihood of confusion when the marks are used concurrently in the geographic areas allotted to each. See *Mid-States Distributing Co. Inc. v Morrison Oil Co.*, 10 USPQ2d 1860, 1862 (TTAB 1989).

The Board will consider any agreements worked out between the parties in determining whether concurrent registrations are to be granted, and if so, the geographic area to be covered by the registrations. See *In re Beatrice Foods Co.*, 429 F.2d 466, 166 USPQ 431 (CCPA 1970). However, mere naked agreements, wherein the measures taken to preclude likelihood of confusion have not been delineated, are not persuasive in resolving the issue of registrable concurrent rights. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987). Therefore, the agreement between the parties must include a recitation of facts and circumstances sufficient to persuade the Board that the concurrent use of the marks by the parties for the same services in their respective geographical areas is not likely to cause confusion. See TBMP Section 1109. See also Rice, Janet E., *Concurrent Use Applications and Proceedings*, 72 Trademark Reporter 403, 408, (1982).

In this case the marks at issue and the services they identify are identical. The settlement agreement submitted by the parties merely expresses the proposed territorial limitations the parties seek in their concurrent use registrations and how abandonment by either party of its mark will affect the concurrent use rights of the other party. The parties' agreement is silent on what measures they have taken to ensure that there will be no likelihood of confusion resulting from contemporaneous use of identical marks in connection with identical services in contiguous territorial areas. For example, the agreement does not specify whether the parties have agreed not to advertise their marks in the geographical area of the other party, whether the parties have initiated measures to prevent actual confusion, whether the parties have established a buffer zone between the geographical areas of the parties, whether any particular aspects of the services or channels of trade may help to preclude likelihood of confusion, whether there are any agreements by the parties to use distinctly different signs or other marks or disclaimers in association with their marks, and whether, in the experience of the parties, concurrent use has resulted in actual confusion. See, for example, *Precision Tune, Inc. v. Precision Auto-Tune, Inc.*, 4 UPQ2d 1095 (TTAB 1987).

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In view thereof, the Board finds that the settlement agreement is insufficient to demonstrate that the parties are entitled to a concurrent use registration for their respective applications.

According the parties are allowed until 90 days from the mailing date of this order to submit a revised or supplemental agreement in an attempt to overcome the deficiencies noted above, or to request that the concurrent use proceeding go forward to trial. In the event that the proceeding goes forward, a scheduling order will be issued and the due date will be set for the filing of statements to the notice of this concurrent use proceeding, pursuant to Trademark Rule 2.99(d)(2).

Proceedings herein will remain otherwise suspended.